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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,154	01/24/2004	Brian K. Owens	2003-0234.02	8152

21972 7590 10/05/2007
LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON, KY 40550-0999

EXAMINER

BRINICH, STEPHEN M

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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10/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10764154	1/24/04	OWENS ET AL.	2003-0234.02

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EXAMINER

Stephen M. Brinich

ART UNIT	PAPER
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2625

20070927

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Office Action Summary	Application No. 10/764,154	Applicant(s) OWENS ET AL.	
	Examiner Stephen M. Brinich	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/12/04</u> . | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 2625

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 6-12, 20-23, & 30-31, 33-35, & 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin et al (US 6094512).

Re claims 1-2 & 21, Lin et al discloses (Figure 1B; column 2, line 40 - column 3, line 28; particularly column 2, lines 40-54 & column 3, lines 1-28) a flatbed scanner having a scanbar 31 and an apertured housing 11 that receives a transparent platen 13 and having a pattern 112 on the undersurface of the housing adjacent to the platen and extending along the length of one edge of the platen.

Re claims 6-11, the pattern is defined (Figure 2; column 2, lines 52-54) by a set of bars of varying lengths and equal thicknesses, in a color that contrasts with the housing color.

Art Unit: 2625

Re claim 12, Lin et al further discloses (column 2, lines 46-47) that the pattern 12 may be in multi-color (i.e. bars of at least two different colors) form.

Re claim 20, Lin et al further discloses (column 2, lines 47-52) forming the pattern by printing it on the housing or sticking a separate printed pattern onto the housing.

Re claims 22-23, Lin et al further discloses (Figure 1B) that the housing 11 has raised edges defining the platen aperture on which the pattern is disposed.

Re claims 30-31, 33-35, & 37-39, Lin et al discloses (Abstract; Figure 4; column 3, lines 46-64) the performing of a pre-scan operation to detect the pattern and determine the platen aperture location so as to produce a final scan of the image of the document on the platen without including the pattern and without losses or errors from inaccurate scan bar motion.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

Art Unit: 2625

art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13-19, 24-26, 32, & 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al.

Re claims 13-19 & 24-26, as noted above, the particular pattern specifically described in Lin et al consists of a plurality of bars (either black and white or multicolored) rather than dots or ridges.

However, Lin discloses (column 2, lines 44-46) that the pattern may consist of generic "graphics" as an alternative to the described "stripes" (i.e. bars). The selection of specific "graphics" consisting of dots or ridges in some particular configuration instead of, or in addition to, the described bars would be a selection from among a set of "graphics" known to one of ordinary skill in the art.

The selection of one of a set of equivalent choices known to one of ordinary skill in the art, where the reasons for the selection of one equivalent rather than another is not to solve an existent problem, has been judicially recognized as an expedient obvious to one of ordinary skill in the art. In re Ruff, 118 USPQ 343 (CCPA 1958).

Re claims 32 & 36, Lin et al does not disclose the manual removal of the pattern image from the scanned image.

Art Unit: 2625

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a manual step in place of an automatic step to accomplish the same result.

The suggestion/motivation for doing so would have been to enable user discretion.

Therefore, it would have been obvious to combine manual operation with Lin et al to obtain the invention as specified in claims 32 & 36.

5. Claims 3-5 & 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al in view of Spears et al (US 2002/0140996).

Re claims 3-5 & 27-28, Lin et al discloses the placement of the above described calibration pattern on one edge of the transparent platen.

Spears et al discloses (Figure 3; paragraphs 00023 & 0025) the placement of a calibration pattern along three edges (including two mutually perpendicular edges) of a transparent flatbed scanner platen.

Lin et al and Spears et al are combinable because they are from the field of flatbed scanner calibration.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide calibration patterns along the other three edges of the platen (as disclosed

Art Unit: 2625

by Spears et al) in addition to providing a calibration pattern along a first edge of the platen (as disclosed by Lin et al).

The suggestion/motivation for doing so would have been to enable calibration at initial and final scanner positions, as described by Spears et al (Abstract) thus allowing faster scanning with reduced error (as described by Spears et al paragraph 0017).

Therefore, it would have been obvious to combine Lin et al with Spears et al to obtain the invention as specified in claims 3-5 & 27-28.

Re claim 29, either of the two corners of the Lin et al platen aperture adjacent to the starting position of the scan bar meets the recited description of the recited "justification corner".

Conclusion

6. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application, entry of papers into this application, or other any inquiries of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-

Art Unit: 2625

272-2600 or to the USPTO Contact Center at 800-786-9199 or 571-272-1000.

The examiner can normally be reached on weekdays 8:00-5:30, alternate Fridays off.

The examiner's unit designation has been changed from "Art Unit 2624" to "Technology Division 2625" (as of March 20, 2006).

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is (as of July 15, 2005) 571-273-8300.

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.



Stephen M Brinich
Examiner
Technology Division 2625

smb

September 28, 2007